

Application Serial No. 10/525,902
Reply to Office Action of July 17, 2007

PATENT
Docket: CU-4101

REMARKS

In the Office Action, dated July 17, 2007, the Examiner states that Claims 1-10 are pending and Claims 1-10 are rejected. By the present Amendment, Applicant amends Claims 1 and 3-10, cancels Claim 2, and adds new Claims 11-15.

In the Official Action, Claims 5-8 are objected to as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. The Applicant has amended the claims to remove the multiple dependencies, and therefore, this objection should be overcome.

In the Official Action, Claim 4 is objected to for an informality. The Applicant has amended the "a" in Claim 4 to "the" as suggested by the Examiner to overcome this objection.

In the Official Action, Claims 9-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Applicant has amended Claims 9 and 10 to recite method steps, and therefore, this rejection should be deemed overcome.

In the Official Action, Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Carrick (U.S. 6,583,092). The Applicant respectfully disagrees with and transposes this rejection. The composition claimed in independent Claim 1 of the present application does not contain zinc dithiophosphate (ZnDTP). In contrast, Carrick discloses a composition containing ZnDTP. Moreover, Example 1 of the present application indicates that a composition without ZNDTP provides better effects than the composition containing ZnDTP. Additionally, independent Claim 1 of the present application claims an antioxidant content in the range of 0.01-5 % by mass. In contrast, Carrick discloses a composition 2 which contains, as an antioxidant: 4.0 wt% of hindered phenolic C₄ ester; 1.5 wt% of nonylated diphenyl amine; and 0.6 wt% of sulfurized cyclic olefin ester. The sum of the antioxidants is 6.1 wt% which is more than the range of the antioxidant claimed in the present application. Therefore, Carrick does not anticipate the present invention because the present invention is distinguishable from Carrick.

In the Official Action, Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Robson (U.S. Pubn. No. 2003/0148895) in view of Emert

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(U.S. 5,498,809). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Robson in view of Emert, and in further view of Curtis (U.S. 2003/0220209). The Applicant has amended independent Claim 1 and Claim 6 to more specifically claim that the compositions comprise the boric acid ester with a specified structure represented by the formula (1) or (2). In contrast, Robson, in paragraph 0073, merely explains that "borate ester may be prepared by reacting one or more of the above boron compounds with one or more alcohols of suitable oleophilicity." Robson does not disclose the specific structure of the borate ester. The example of Robson, in footnote of Table-1 at paragraph 0137 discloses the only borated compound which is described as a "borated dispersant."

Additionally the Applicant has amended independent Claim 1 to more specifically claim that the preferred aromatic content is 10% by mass or less. In contrast, Robson, in paragraph 0064, discloses a preferred base oil "Group I" in parallel "Group III". "Group I" is a base oil which contains less than 90% of saturates, and therefore, must contain 10% or more aromatics.

Therefore, the amendments made by the Applicant should overcome any rejections to the claims with respect to Robson, Emert, and Curtis. Moreover, the Applicant believes Curtis is an improper reference because it discloses the use of fuel containing 15 ppm or less of sulfur, with a composition that contains an amide of an aliphatic carboxylic acid as an essential component. Neither the present invention nor the other cited references requires such an essential component.

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

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Date



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